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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/582,372	09/07/2000	Hans Wyssmann	1.G164.183	3232

7590

07/26/2005

Bugnion S A
10 Route De Florissant
Case 375
Geneva, CH 1211
SWITZERLAND

EXAMINER

GOODMAN, CHARLES

ART UNIT	PAPER NUMBER
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3724

DATE MAILED: 07/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/582,372

Applicant(s)

WYSSMANN ET AL.

Examiner

Charles Goodman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 8, 10-12, 16, 17, 21, 22 and 25 is/are rejected.
- 7) ☒ Claim(s) 6, 7, 9, 13-15, 18-20, 23, 24 and 26 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

1. The Preliminary Amendment filed on August 24, 2001 has been entered.

Specification

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or
REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)
- (f) BACKGROUND OF THE INVENTION.
 - (1) Field of the Invention.
 - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (g) BRIEF SUMMARY OF THE INVENTION.
- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (i) DETAILED DESCRIPTION OF THE INVENTION.
- (j) CLAIM OR CLAIMS (commencing on a separate sheet).
- (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

2. The disclosure is objected to because of the following informalities:
 - a. The specification lacks proper headings. Note *supra*.
 - b. P. 1, l. 4, any reference to a claim in the specification should be deleted, e.g. the phrase "...preamble of claim 1", since what a claim may or may not recite has yet to be determined.Appropriate correction is required.

Claim Objections

3. Claims 6, 7, 9, 13-15, 18-20, 23, 24, and 26 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim must be in the alternative or they may not depend from another multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims have not been further treated on the merits.

The following breaks down the various issues with the above mentioned claims:

Claim 6 is not in the alternative, i.e. the term "or" should be applied.

Claims 7, 9, 13, and 14 are multiple dependent claims depending from other multiple dependent claims 6, 7, and 11 respectively.

Claims 15, 18-20, 23, 24 and 26 are depending claims dependent upon improper multiple dependent claims 14, 6, 9, 7, and 13 respectively.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-5, 8, 10-12, 16, 17, 21, 22 and 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- i. The following phrases lack clear antecedent basis: (claim 1) “the transporting direction” and “the longitudinal strips of the sheets...cut longitudinally”; (claim 10) “the second cross cutting device”; (claim 12) “the transporting arrangement...banknotes” and “the cut banknotes”.
- ii. Claim 5 is vague and indefinite in that it is not clear what the claim encompasses. What does the “inspection box” inspect?
- iii. Claim 8 is vague and indefinite in that it is not clear what the term “it” is referring to, i.e. the processing machine or the cross cutting device. Substantially the same applies to claims 16 and 17.
- iv. Claim 11 is vague and indefinite in that it is not clear what the claim encompasses. First, the term “it” is vague and indefinite in that it is not clear what feature(s) the term is referring to. Second, the claim is not clearly understood to the extent that the claim includes double inclusions of many of the elements set forth in claim 1, e.g. “chain conveyor”. Thus, how is the claim further limiting invention. Substantially the same applies to claims 21, 22, and 25.
- v. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered

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indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 12 recites the broad recitation "transporting means", and the claim also recites "a transporting belt" which is the narrower statement of the range/limitation. Furthermore, the limitation is vague and indefinite in that it is not clear what the claim encompasses to the extent that claim 1 already sets forth a "chain conveyor". Thus, what is the difference, if any, between the "transporting means", "transporting belt" and the "chain conveyor"? On the other hand, this limitation will be read as only being limited to a "transporting belt". Note MPEP § 2181 and § 112, 6th paragraph issues.

Claim Rejections - 35 USC § 103

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1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. As best understood, claims 1, 5, 8/1, 10/8/1, 12/10/8/1, 11/1, 17, 22 and 25/8/1 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuhfuss (US 4,793,251) in view of Schaede (US 5,640,908).

Kuhfuss discloses the invention substantially as claimed including, inter alia, at least one cross cutting device (e.g. Fig. 6); longitudinal cutting device (e.g. 3 or 6); an inspection box (i.e. detector (not shown) - c. 6, ll. 4-8) except for chain conveyors with grippers. See whole patent. It is noted that Kuhfuss includes conveyors with grippers (note the features indicated by arrows in Fig. 2 near reference (7c)) but not clear as to what type. Note e.g. 10 in the Figures. However, Schaede teaches that chain conveyors are well known equivalent conveying means in the art of sheet processing devices for

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positively gripping and moving sheets from place to place. Note the chain conveyor having grippers (e.g. 11). Thus, it would have been obvious to the ordinary artisan at the time of the instant invention to substitute the chain conveyor and gripper as taught by Schaede for the generic conveyor and gripper in Kuhfuss in order to facilitate positive gripping conveyance of the sheets to be processed, since the choice of one for the other is deemed to be an obvious matter of design choice, since both are deemed to be equivalents in the art, and since both appeared to work equally well.

4. As best understood, claims 2, 3, 8/3 or 2, 10/8/2 or 3, 12/10/8/2 or 3, 25/8/2 or 3 and 11/2 or 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuhfuss (US 4,793,251) in view of Schaede (US 5,640,908) as applied to claims 1, 5, 8/1, 10/8/1, 12/10/8/1, 11/1, 17, 22 and 25/8/1 above, and further in view of Young (US 3,855,891).

The modified device of Kuhfuss discloses the invention substantially as claimed except for the cross cutting device having a fixed mating blade, i.e. the cross cutting device has two rotary cutting cylinders. However, Young teaches an equivalent cross cutting device comprising a rotating cylinder (e.g. 3) having at least one cutting blade (2) interacting with a fixed mating blade (e.g. 4) for the purpose of providing a scissor cut to the sheets being processed which suggests a more accurate cross cut to the sheets; the blades being arranged in the manner claimed. See whole patent. Thus, it would have been obvious to the ordinary artisan at the time of the instant invention to substitute the rotating cylinder and fixed blade as taught by Young for the two rotary cylinders of Kuhfuss, modified, in order to facilitate a more accurate cross cut to the sheets during processing.

5. As best understood, claims 4, 16 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuhfuss (US 4,793,251) in view of Schaede (US 5,640,908) as applied to claims 1, 5, 8/1, 10/8/1, 12/10/8/1, 11/1, 17, 22 and 25/8/1 above, and further in view of Bolza-Schuenemann et al (US 5,329,852).

The modified device of Kuhfuss discloses the invention substantially as claimed except for a suction box. However, Bolza-Schuenemann et al teaches a suction box (3, 4) in a sheet processing device for the purpose of insuring accurate inspection of the processed sheets. See whole patent. Thus, it would have been obvious to the ordinary artisan at the time of the instant invention to provide the modified device of Kuhfuss with the suction box as taught and suggested by Bolza-Schuenemann et al in order to facilitate positive retention of the sheets for inspection purposes.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Goodman whose telephone number is (571) 272-4508. The examiner can normally be reached on Monday-Thursday between 7:30 AM to 6:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan Shoap, can be reached on (571) 272-4514. In lieu of mailing, it is encouraged that all formal responses be faxed to (703) 872-9306. Beginning July 15, 2005, the new fax number will be changed to **(571) 273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

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published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should


you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at (866) 217-9197 (toll-free).



Charles Goodman
Primary Examiner
AU 3724

cg



July 25, 2005

CHARLES GOODMAN
PRIMARY EXAMINER